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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,733	10/03/2005	You-Ping Chan	022290.0122PTUS	8573
33942 7590 02/26/2009 PATTON BOGGS LLP 8484 WESTPARK DRIVE SUITE 900 MCLEAN, VA 22102				
EXAMINER				
LUKTON, DAVID				
ART UNIT		PAPER NUMBER		
1654				
MAIL DATE		DELIVERY MODE		
02/26/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/516,733

**Applicant(s)**

CHAN ET AL.

**Examiner**

DAVID LUKTON

**Art Unit**

1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15, 17-24 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5, 8-10, 15, 17-23 and 26 is/are allowed.
- 6) ☒ Claim(s) 6, 7, 11-13 and 24 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/17/08 has been entered.

Pursuant to the response filed 12/17/08, several claims have been amended. Claims 1-15, 17-24 and 26 are now pending.

Claims 6, 7, 11-13, 24 are now rejected, claim 14 is objected to (because of its dependence on a rejected claim), and claims 1-5, 8-10, 15, 17-23, 26 are characterized as allowable.

✦

Claim 6 is objected to on grammatical grounds. This claim recites the following:

“the polyamino acids comprises”.

This is construct is grammatically incorrect.

✦

Claims 6, 7, 11-13, 24 are rejected under 35 U.S.C. §112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 6 is dependent on claim 2, and claim 2 is dependent on claim 1. Claim 1 recites the term “polyamino acid” (in the singular), and claim 2 recites the term “polyamino acids” (in the plural). Claim 6 recites the term “polyamino acids” (in the plural). But the phrase at issue in claim 2 refers specifically to polylysine and oligolysine, and not to Asp or Glu. So it may be true that it would be inaccurate

to simply say that, in claim 6, the term “polyamino acids” (in the plural) lacks antecedent basis, but if the phrase at issue in claim 6 is referring back to the corresponding phrase in claim 2, then claim 6 is not properly subgeneric to claim 2. The same issue applies in the case of claim 7.

- Claim 12 recites (line 1) “The polyamino acid ... of formula II”.

Thus, claim 12 is asserting that formula II describes, not a portion of the polyamino acid, but rather the entire, complete polyamino acid itself. However, there is no requirement or suggestion that the polyamino acid of claim 12 contain any aspartic or glutamic acid units. Accordingly, claim 12 is not properly subgeneric to claim 11, or even to claim 1.

- Claim 13 recites the term “polyalkylene glycol type”. This renders the claim indefinite as to the manner in which, or the extent to which the graft must resemble polyalkylene glycol in order to qualify as a “polyalkylene glycol type”. The same issue applies in the case of claim 11.
- Claim 24 is dependent on a cancelled claim.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton whose telephone number is 571-272-0952. The examiner can normally be reached Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached at (571)272-0562. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

/David Lukton/

Primary Examiner, Art Unit 1654